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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,970	03/08/2004	Michael Conte	99823-00002	8633

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EXAMINER
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GRAY, PHILLIP A

ART UNIT	PAPER NUMBER
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3767

MAIL DATE	DELIVERY MODE
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06/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/795,970

Applicant(s)

CONTE, MICHAEL

Examiner

Phillip Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 4-12 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-12 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to applicant's communication of 4/19/2007. Currently amended and newly added claims 1, 4-12 and 22-27 are pending and stand rejected below.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 4-12 and 22-27 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Objections***

Claim 22 is objected to because of the following informalities: The term "corresponding to one or more internally facing protrusions" is confusing and nondescript. There is no reference point to what is "internal" and "external" on the device. Since the applicant's claim comprises a safety syringe and cap holding device it is not certain which device/direction/spatial orientation is "internal" facing (in relationship to the cover, the hub, the syringe, or the cap holding device or other area). Examiner is unable to ascertain which direction is "corresponding" with the "internal facing". It is recommended that the applicant amend the claims to add in a reference point or identify what is internal and external to which exact element. Currently applicant is reading the broadest reasonable interpretation on the terms. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, 9-10, 12 and 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Staebler (U.S. Patent Number 4,742,910). Staebler discloses a hypodermic needle sheath holder. Staebler discloses a safety syringe and cap holding device (fig 1-4) comprising a syringe (35) with needle (34) and hub (40), a cover (28), a cap holding device (10) and this system is fully capable of the means for disengaging the cover from the hub and retaining the cover in the cap holding device to allow the syringe and needle assembly to be withdrawn from the cap holding device with the injection end uncovered while the cover remains in the cap holding device (operation of Staebler as described in columns 1-3).

It is examiners position that the hub has an annular recess about the hub and the cover comprises at least a pair of protrusion for engagement with therecess of the hub (as in fig.4, upper and lower protrusions on opening of cover 28 which contact annular recess space on hub 40. Further Staebler comprises a remotely actuated linkage system (as shown in figures 1-4 and by actuator elements 10 or 22 or actuated by operator themselves) with hooks (24) for engaging handles on the cover (area contacted by hooks on cover 28 and also area near 32) for disengaging the protrusions away from the recess to disengage the cover from the hub (as in the operation described in columns 1-3). Further the cover/cap holding means can selectively retain

and release the cover (cap) and this would include the tip of the cover (cap) (engagement means near 32). Further the base of the Staebler cap holding device base is weighted.

Concerning claim 22, it is examiners position that cap/cover 28 include "handles" which correspond to internal facing protrusions (see claim objection above). Further examiner is reading the last paragraph of the claim 22 as a "means for" claim limitation and is of the position that Staebler discloses this cap disengaging operation/function and is also in not exactly like the applicants "means for" the prior art is an equivalent thereof.

Concerning claim 27 it is examiners position that the actuator (such as element 22) is not integrally attached to the housing (12) since they are formed of two separate pieces (as in figure 4).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7,8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staebler.

Concerning claims 7,8,11, Staebler discloses the claimed invention except for a plurality of solenoids, which actuate the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a plurality of solenoids, which actuate the device, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192 (CCPA 1958).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571) 272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

